

REMARKS

Reconsideration of the above-identified application is respectfully requested in view of the following amendments and remarks.

Claims 1-16 are pending and stand rejected.

Claims 1, 6 and 11 are independent claims.

Claim 11 has been amended solely to present the subject matter claimed in better form.

Claims 1, 2, 4-7, 9-12 and 14-16 stand rejected under 35 USC 103(a) as being unpatentable over Mok (USPPA 2004/0013416, hereinafter D1) in view of Kanada (US 2004/0006607, hereinafter D2). Claims 3, 8 and 13 stand rejected under 35 USC 103(a) as being unpatentable over D1 and D2 in view of Yun (USP no. 7,565,672, hereinafter D3).

With regard to the rejection of claims 1, 2, 4-7, 9-12 and 14-16 as being unpatentable over D1 and D2, applicant respectfully disagrees with, and explicitly traverses, the rejection of the claims.

The Office Action asserts that D1 discloses the claim elements of an optical disc playing method comprising receiving a command, sending a request, which requires related information of the part of content be provided, the request including at least identification information (*figs. 1-2, par. 0023, lines 7-13, par. 0036, lines 3-9 and par. 0028, controller reads meta data for receiving access information and meta data includes file information stored on the optical disc*), receiving the related information and playing the part of content with the received related information, wherein the received navigation information is used in coordination with navigation information on said optical disc to play the part of the content with the received related information (*figs. 1-2, par. 0023, lines 14-21, para. 0029, para. 0036, lines 9-15 and par. 0042, reproduce data recorded on the optical disc with navigation display screen*).

The Office Action acknowledges that D1 does not teach sending a request to a network server, the request including at least identification information of the optical disc.

The Office Action refers to D2 for teaching an optical disc playing method comprising: sending a request to a network server, the request including at least identification information of the optical disc (*see abstract, lines 9-13, Figure 1 and 6-7, and page 6, para. 0076-0084*).

The Office Action asserts that it would be obvious ... to incorporate the teachings of D2 in the method of D1 for playing an optical disc because it would have improved the music distribution service and also prevent copyright from being infringed.

D1, as read by the applicant, discloses a system for obtaining additional information associated with a file by obtaining metadata information associated with the file and outputting the resultant additional information. With reference to para. 0023, which is referred-to in the Office Action, D1 teaches the metadata files are necessary for controlling playback of the contents. D1 further provides an example of the device disclosed, wherein when “a contents file includes an MP3 file, the optical disc player gains access to image data and audio data.” (see para. 0029).

That is, D1 teaches that the metadata associated with a file includes information that allows additional information associated with the file to be displayed or presented.

However, nowhere does D1 teach or suggest that the metadata or the additional information associated with the metadata includes identification information of the optical disc. Rather, D1 teaches that the information is related to a file or media and is stored on the optical disc. Hence, identification of the disc is not applicable to the device described by D1.

D1 fails to provide any reason to communicate with a network server or provide identification regarding the disc to a network server, as is recited in the

claims, as D1 teaches the metadata is stored on the disc, which includes the required additional information.

D2 discloses a system for providing a unique identification value post-scribed on a compact disc (CD) to a registration system. The identification value defines the content associated with the CD. With the registration of the CD to the server, the server knows the content of the CD and the user may download the content associated with the CD in a different format. Thus, the user is not burdened with converting CD formatted content to portable terminal formats (e.g., mp-3) or have to repurchase the content associated with the registered CD in the portable terminal format. (see para. 0026, “[w]hen the end user has bought a recording medium, he or she performs a registration process for the recording medium with a user terminal (personal computer) through a network. The addition, the end user sends identification information to a management server of a content provider. With the identification information, a list that represents music pieces that each user owns is created. *Corresponding to the list, music pieces that each user owns can be permitted to be reproduced or downloaded free of charge or at a low price.*”).

Thus, D2 allows a user to obtain the same information (e.g., music files) that has been purchased in a CD format in a different format (e.g., mp-3).

With regard to the assertion that it would be obvious to amend D1 to incorporate the network features of D2, Applicant submits that in addressing obviousness determination under 35 USC 103, the US Supreme Court in *KSR International Co. v. Teleflex Inc.*, (citation omitted) reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” In this regard, the Court stated that

“it can be important to identify a reason that would have prompted a person of ordinary skill in the ... field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”

Furthermore, the Court did not diminish the requirement for objective evidence of obviousness (“[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention. i.e., something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination. Uniroyal Inc. V. Rudlkin-Wiley Corp (citation omitted).

In this case, D1 teaches a system in which an optical disc is a self-contained unit wherein metadata files stored on the disc provide additional information associated with content files stored on the optical disc. Accessing the metadata enables an optical player to gain access to image data and audio data associated with the content files. The image data and audio data may be played in conjunction with the content file. D1 fails to have need of an optical disc identifier to access the stored metadata.

D2 teaches a system that provides a unique identification of an optical disc to a server. The server, having information regarding the identification, determines the content of the optical disc, and then provides the same content contained on the optic disc but in a different format.

Thus, a system incorporating the teachings of D2 into D1 would create a system that includes a disc identification that may be provided to a network server, which then provides to the system **the same data already stored on the disc in a different format**. The device resulting from the combination of D1 and

D2 may then reproduce (play) the same content that is contained on a purchased CD. For example, if a user purchases a CD with music files, the device (system) of D1 and D2 would allow the user to play the content of the purchased CD on an mp-3 player.

In this case, the combination of the cited references fails to disclose the element of “playing said part of content with the received related information, ***wherein the received navigation information is used in coordination with navigation information on said optical disc to play the part of the content with the received related information.***” Rather the content provided by the combination of D1 and D2 is *the same contain that is stored on the optical disc in a different format. Thus, either the original content (on the CD) or the downloaded content (in the different format) is played. The combination of D1 and D2 fails to teach coordination of the information on the optical disc with the received related information.*

Thus, the combination of the cited references cannot render obvious the subject matter recited in the aforementioned independent claims, as the combination of the cited references fails to disclose a material element recited in the claims.

Furthermore even, assuming arguendo, that the additional information stored in the metadata of D1 were stored on a network server, and the identification of the optical disc is provided to the network server, as suggested by the Office Action, the network server in response to a request to provide the additional data, would provide the additional data in a different format.

Hence, the player receiving the additional data (which according to D2, is the same data on the optical disc and not actually additional data), which is in a different format, cannot “***play[ing] said part of content with the received related information,*** wherein the received navigation information is used in coordination with navigation information on said optical disc to play the part of the content with the received related information.”

Rather, because the information provided from the network server is in a different format, the ***player cannot “play the part of the content with the received related information.”***

Accordingly, nothing in the prior art as a whole must suggests the desirability and thus the obviousness of making the combination of D1 and D2 as the combination of D1 and D2 fails to “***play the part of the content with the received related information.”***

Rather, the combination of D1 and D2 cannot “play the content [on the disc] with the received related information” as the data are in different formats and, thus the disc content and the received related information (i.e., the downloaded additional information) are played separately.

In addition, while the Office Action has asserted it would be obvious to combine D1 and D2 because it would have improved the music distribution service and also prevent copyright from being infringed, D1 fails to provide any teaching regarding improving music distribution or preventing copyright infringement.

Rather D1 provides additional information regarding content on an optical disc, wherein the additional information is contained on the optical disc. Thus, the music (assuming the content stored on the optical disc is music) is already distributed to the user as the user has possession of the disc and there is no need for the user to have any need for other distribution means.

Similarly, copyright infringement is not an issue with D1 as the user of D1 has possession of the optical disc which contains the additional information. As the user has possession of the materials on the optical disc, there cannot be any copyright infringement.

Thus, there is no rational underpinning for incorporating the teachings of D2 into D1 to improve music distribution and/or prevent copyright infringement, as is asserted in the Office Action.

Applicant submits that the reason for the rejection of the independent claims, and the claims dependent therefrom, under 35 USC 103(a) has been overcome as it has been shown that the independent claims include subject matter patently distinguishable over the teachings of the cited references, and nothing in the prior art as a whole suggests the desirability and thus the obviousness of making the combination of D1 and D2.

With regard to the rejection of the remaining claims under 35 USC 103, applicant submits that these claims depend from one of the independent claims, which has been shown to be patently distinguishable over the cited references. The remaining cited reference fails to provide any teaching to correct the deficiency found to exist in the combination of D1 and D2.

Accordingly, the remaining claims are also not rendered obvious by the combination of the cited references.

For the remarks made herein, applicant submits that the reason for the rejection of the claims has been overcome and respectfully requests that the rejections be withdrawn and a Notice of Allowance be issued.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this

Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In order to advance the prosecution of the matter, applicant respectfully requests that any errors in form that do not alter the substantive nature of the arguments presented herein be transmitted telephonically to the applicant's representative so that such errors may be quickly resolved or pursuant to MPEP 714.03 be entered into the record to avoid continued delay of the prosecution of this matter any further.

MPEP 714.03 affords the Examiner the discretion, pursuant to 37 CFR 1.135 (c), to enter into the record a bona fide attempt to advance the application that includes minor errors in form.

"[a]n Examiner may treat an amendment not fully responsive to a non-final Office Action by: (A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment ... (B) notifying the applicant that the reply must be completed... (C) setting a new time period for applicant to complete the reply ...

The treatment to be given to the amendment depends upon:

(A) whether the amendment is bona fide; (B) whether there is sufficient time for applicant's reply ... (C) the nature of the deficiency.

Where an amendment substantially responds to the rejections, objections or requirements in a non-final Office action (and is bona fide attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection or requirement not addressed by the amendment (or otherwise

indicate that such rejection, objection or requirement is no longer applicable).

This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action)..."

However, if the Examiner believes that such minor errors in form cannot be entered into the record or that the disposition of any issues arising from this response may be best resolved by a telephone call, then the Examiner is invited to contact applicant's representative at the telephone number listed below to resolve such minor errors or issues.

Amendment
Docket No. 2003P00763WOUS
Serial No. 10/578,377

No fees are believed necessary for filing this amendment.

Respectfully submitted,
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Date: January 4, 2012

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